

The Examiner has further required, should Applicants elect to prosecute the invention of Group I (claims 1-78), election of one of the following three species for prosecution on the merits to which the claims shall be restricted should no generic claim finally be held to be allowable:<sup>1</sup>

- Species A: inclusive of drug classification (claims 1-57 and 72-78);
- Species B: inclusive of drug efficacy evaluation (claims 1-50, 58-64 and 72-78);  
and
- Species C: inclusive of drug toxicity evaluation (claims 1-50 and 65-78).

The Examiner contends that the inventions of Groups I and II are distinct, each from the other. Specifically, the Examiner contends that the inventions are related as product and process of use. Accordingly, the Examiner alleges, the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product. The Examiner contends that in the instant case, the process of Group I can be performed on the claimed computer system of Group II or could be performed by hand. The Examiner also contends that species A-C are distinct because they require at least certain different determinations such as drug efficacy evaluation (*e.g.*, Species B) and/or drug toxicity evaluation (Species C). Thus, the Examiner contends that the species each require significantly different searches.

In order to be fully responsive, Applicants hereby elect, with traverse, to prosecute the invention of Group I, claims 1-78, drawn to methods of determining or grouping consensus profiles (classified in Classes 435 and 436, subclasses 4 and 63, respectively), and Species B, claims 1-50, 58-64 and 72-78, inclusive of drug efficacy evaluation. However, Applicants reserve the right to petition from the Restriction Requirement under 37 C.F.R. § 1.144, and respectfully traverse the Examiner's division of the invention into two groups and three species. Specifically, even assuming *arguendo* that Groups I and II represent distinct or independent inventions, Applicants submit that the Restriction would not be proper since, contrary to the Examiner's contentions, it would not be a serious burden for the Examiner to

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<sup>1</sup> The Examiner has noted that claims 1-50 and 72-78, as currently pending, are generic to species A-C, above.

search the subject matter of Group I, species A-C and Group II together. M.P.E.P. § 803 (Seventh Edition, July 1998) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, under M.P.E.P § 803, all of claims 1-88 should be searched and examined in the present application. Accordingly, Applicants respectfully request that the Restriction Requirement under 35 U.S.C. § 121 be withdrawn and the presently pending claims be examined in one application.

Applicants respectfully request that the above-made remarks be considered and made of record in the file history of the above-captioned application.

Respectfully submitted,

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Enclosure